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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/624,581	07/22/2003	Holger Soring	SOR 205	7516
7590	07/03/2007			
Horst Kasper 13 Forest Drive Warren, NJ-07059			EXAMINER KOHARSKI, CHRISTOPHER	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 07/03/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/624,581	Applicant(s) SORING ET AL.	
	Examiner Christopher D. Koharski	Art Unit 3763	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☒ Claim(s) 1-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

Examiner acknowledges the reply filed 2/27/2007 in which Applicant's Representative elected Group I with traverse. Applicant's arguments are found persuasive and therefore the election/restriction is withdrawn. Currently claims 1-32 are pending for examination in this application.

Information Disclosure Statement

Examiner acknowledges that the information disclosure statement (IDS) filed with this application is incorrect, the patent inventor and patent number do not match and the patent is not contain any seemingly relevant subject matter, accordingly, the examiner is not considering any information disclosure statements filed at this time.

Specification

The disclosure is objected to because of the following informalities: The form of the specification does not meet current MPEP standards with the correct section headings and form (see MPEP 601).

Appropriate correction is required.

Claim Objections

Claims 1-32 are objected to because of the following informalities: The claims contain numerous errors (grammatical, antecedent basis, language) and are also vague because of language errors, Examiner requests Applicant's Representative examine and correct the deficiencies in this application prior to further action, some examples are:

Claim 1: "characterized" – improper US form claim language

Claim 2: "character" – word is improper; "the suction apparatus" –lacks antecedent basis

Claim 3: "characterized" – improper US form claim language; "a suction tube out of an opaque" – missing words

Claim 7: "in that an adaptation sleeve can be slide..." – claim seems to cover subject matter already present in claim 1.

Claims 13 and 14: claims subject matter seems to a repeated of prior claimed subject matter.

These same errors appear in several other claims, and are carried through duplicate dependant claims. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-27 and 29-32 are rejected under 35 U.S.C. 102(b) as being anticipated by Banko (3,805,787). Banko discloses an ultrasonic surgical instrument.

Regarding claims 1-27 and 29-32, Banko discloses a medical treatment device (10) with a hand piece (near 19) equipped with an ultrasound vibration generator (14) and a sonotrode (24) attached to the hand piece, wherein an adaptation sleeve (40) can be slid over the sonotrode with the sonotrode extending beyond the sleeve and

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containing a connector (40, 50) for receiving a suction hose with a separator between the suction apparatus (32) and the suction hose (32a) (Figures 1-7A) and a flushing line (30a) from an irrigation source (30) that are aligned with the axis of symmetry of the handpiece (Figure 4). Additionally, Banko discloses that the adaptation sleeve is made of opaque stainless steel (col 4, ln 1-10) and the ultrasound apparatus is capable of providing a frequency of 5kHz to 60kHz and preferably from 15 kHz a to 30 kHz (col 2, ln 50-70).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 28-29 are rejected under 35 U.S.C 103(a) as being unpatentable over Banko in view of Mallet et al. (6,592,595). Banko meets the claim limitations as described above except for the HEPA filter trap system.

However, Mallet et al. teaches a microderm suction apparatus.

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Regarding claims 28-29, Mallet et al. teaches a filter system (32) containing a HEPA filter (203) (Figure 9).

At the time of the invention, it would have been obvious to add the filter trap system of Mallet et al. to the system of Banko et al. in order to contain potentially harmful body fluids from the body. The references are analogous in the art and with the instant invention; therefore, a combination is proper. Therefore, one skilled in the art would have combined the teachings in the references in light of the disclosure of Mallet et al.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Christ et al. (5,984,889).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher D. Koharski whose telephone number is 571-272-7230. The examiner can normally be reached on 7:30am to 4:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nick Lucchesi can be reached on 571-272-4977. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Date:

6/18/2007



Christopher D. Koharski
AU 3763



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